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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/617,935

07/11/2003

Catherine Drogin

465/2

3966

7590

07/27/2004

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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/617,935	Applicant(s) DROGIN ET AL.	
	Examiner David Comstock	Art Unit 3732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20 October 2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The language "ink approved by the U.S. Food and Drug Administration" and other similar phraseology in the specification does not adequately convey to a person skilled in the art the type of ink that is to be used, thus requiring undue experimentation to determine the same.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language "ink approved by the U.S. Food and Drug Administration" and "U.S. Food and Drug Administration Ink" does not specifically set forth the metes and bounds of the invention. It is noted that the approval status of ink can change over time, effectively changing the scope of the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Esker et al. (5,946,773).

Esker et al. disclose a device 10 comprising a sterile blade 12 having a first side 16 and a second side 18 (see Figs. 1-6 and col. 1, lines 4-9). Various ornamental images formed of biocompatible inks appear on both sides 16, 18 of the device (id. and see col. 2, lines 25-37 and col. 4, lines 1-16 and 60-63). It is noted that an image on the first side can be the same as an image on the second side, e.g. a bunch of grapes (see Fig. 3). In addition, an image on the first side, e.g. a bunch of grapes, can be different from an image on the second side, e.g. an apple. The sides 16, 18 of the device can be contacted by a user's tongue. Any portion of the device, including a portion with an image, can be received within a user's mouth due to the biocompatibility of the ink forming the images and an additional biocompatible protective layer (see col. 2, lines 38-48). The device is made of plastic, i.e. styrene, and is protected with a layer of plastic (see col. 2, lines 38-51).

Claims 1, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Daly et al. (910,914).

Daly et al. disclose a disposable utensil 10 comprising a sterile wooden blade having first and second sides (see Fig. 2; col. 1, lines 30-31, 36-37, 47-49). The first and second sides can contact a user's tongue. The device includes ornamental advertising images formed of non-poisonous ink that does not interfere with the hygienic qualities of the utensil (see Fig. 2 and col. 1, line 55 - col. 2, line 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (2004/0109932) in view of Esker et al. (5,946,773).

Chen et al. disclose a flavored tongue depressor, which includes two sides and two tongue contact portions (see paragraphs 0002, 0003, 0063 and 0064). Tongue depressors are sterile. Chen does not disclose providing an ornamental image. Esker et al. disclose a similar device having decorative images formed from biocompatible inks on both sides of the device to make the device attractive and entertaining and to make the device more valuable to the user (see Figs. 1-6; col. 2, lines 25-37; and col. 4, lines 1-16 and 60-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tongue depressor of Chen et al. with decorative images formed from biocompatible inks on both sides of the device, in view

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of Esker et al., in order to make the device attractive and entertaining and to make the device more valuable to the user. It is noted that providing different images on the two sides would have been an obvious matter of design choice, since applicant has not disclosed that providing the images in this way solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without providing the images in this manner. Moreover, providing different images on each side is merely one of numerous configurations a person of ordinary skill in the art would find obvious. *In re Dailey and Eilers*, 149 USPQ 47 (1966). The sides of the device of the combination of Chen et al. and Esker et al. can be contacted by a user's tongue, and any portion of the device, including a portion with an image, can be received within a user's mouth due to the biocompatibility of the ink forming the images and an additional biocompatible protective layer (see col. 2, lines 38-48). With regard to claims 6 and 12, it would have been further obvious to provide this device with ink approved by the FDA, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It also would have been obvious to form this device from wood, plastic, cardboard, or any of numerous other known materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esker et al. (5,946,773).

Esker et al. disclose the claimed invention except for explicitly reciting that the ink is approved by the FDA. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Esker et al. with ink approved by the FDA, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 2-6, 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al. (910,914).

Daly et al. disclose the claimed invention except for explicitly reciting that the image appears on both sides of the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate these images so as to have them on both sides of the device, since it has been held that mere duplication of the essential elements of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Furthermore, it is noted that providing different images on the two sides would have been an obvious matter of design choice, since applicant has not disclosed that providing the images in this way solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without providing the images in this manner. Moreover, providing different images on each side is merely one of numerous configurations a person of ordinary skill in the art would find obvious. *In re Dailey and Eilers*, 149 USPQ 47 (1966).

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With regard to claims 6 and 12, Daly et al. does not explicitly recite that the ink is approved by the FDA. It would have been further obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Daly et al. with ink approved by the FDA, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With regard to claims 9 and 10, Daly et al. do not disclose forming the device from cardboard or plastic.

However, it also would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device from cardboard or plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al. (910,914) in view of Chen et al. (2004/0109932).

Daly et al. disclose the claimed invention except for the flavor coating. Chen et al. disclose providing such utensils as wooden sticks, tongue depressors and garnish skewers with a flavor coating to create an effect that consumers enjoy and to enhance consumer preference for particular products (see paragraphs 0002, 0003, 0063 and 0064). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the utensil of Daly et al. with a flavor coating, in view of Chen et al., in order to create an effect that consumers enjoy and to enhance consumer preference for the utensil.



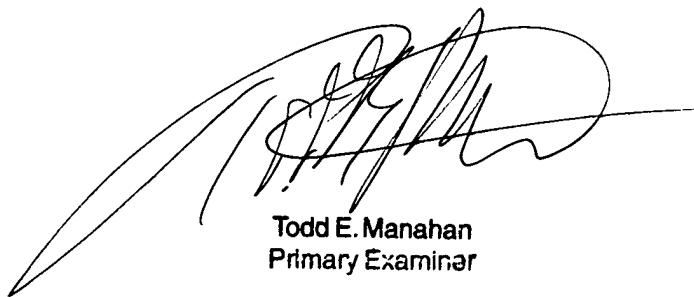
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock  
25 July 2004



Todd E. Manahan  
Primary Examiner